

REMARKS/ARGUMENTS

In light of the above amendments and following remarks, reconsideration and withdrawal of the rejections of the application are respectfully requested.

The instant After-Final Amendment is being made to facilitate prosecution of the application and does not require a further search. Therefore, Applicant respectfully requests that the instant Amendment be entered.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-12, 14-26 and 28-47 are pending in this application. Claims 5, 7-12, 19, 21-26 and 29-47 have been withdrawn from consideration. Claims 1-4, 6, 14-18, 20 and 28 have been rejected in the Office Action. In this response, claims 1-4, 6, 14, 15 and 28 have been amended. Support for the amended claims can be found in the specification on page 6, lines 3-7. No new subject matter is added as a result of the amended claims.

It is submitted that these claims are patentably distinct from the prior art cited by the Examiner, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112, but rather the amendments and remarks made herein are simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. THE REJECTIONS UNDER 35 U.S.C. § 102(b) AND 35 U.S.C. § 102(e) AND 35 U.S.C. § 103(a)

In paragraph 6 of the Office Action, claims 1-4 and 6 have been rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 3,800,019 to Parsey et al. ("Parsey"). In paragraph 7 of the Office Action, claims 1-4 and 6 have been rejected under 35 U.S.C. § 102(e) as anticipated by or, in the

alternative, under §103(a) as obvious over U.S. Patent No. 6,653,943 to Lamb et al. ("Lamb"). In paragraph 8 of the Office Action, claims 1-4, 6, 14-18, 20 and 28 have been rejected under § 103(a) as being unpatentable over U.S. Patent No. 5,685,014 to Dapsalmon ("Dapsalmon") in view of any one of Parsey or Lamb. Lastly, in paragraph 9 of the Office Action, claims 1-4, 6, 14-18, 20 and 28 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,786,243 to Moriarity et al. ("Moriarity") in view of any one of Parsey or Lamb. The rejections are traversed for at least the following reasons.

As recited in revised claim 1, the instant invention is directed to a multilayer filament for use in an industrial fabric used in papermaking and related industries where the multilayer filament has a core comprised of a single yarn surrounded by a plurality of respective layers and a means for indicating the level of wear of an industrial fabric comprised thereof. Therefore, in the instant invention, an individual single yarn is surrounded by a plurality of wear indicating layers. See page 6, lines 3-17.

In contrast, Parsey is directed to a rope structure constructed from a core of at least one bundle of filaments, wherein the core may be bound by a steel tape or wire or sheathed with two organic coatings of different colors. In these configurations, damage or wear to the rope can be detected by measuring the resistance between the steel binding means or by a change in the color on the outside of the rope. See col. 1, line 39 - col. 2, line 29. As used in Parsey, a bundle is used "to denote a group of filaments arranged in parallel fashion. Such a group may be assembled by combining together without twisting a number of filamentary yarns to produce the larger bundle required for a rope core." Col. 3, lines 50-55. Therefore, Parsey teaches a bundle

or plurality of filaments that are sheathed, whereas the instant invention teaches a core comprised of a single yarn that is surrounded by a plurality of respective layers.

Lamb, in contrast, is directed to suspension ropes having polyurethane sheaths as used, for example, in an elevator assembly. Col. 2, lines 26-28. As depicted in Figure 1a, the suspension or wire rope 4 is constructed from a wire rope that includes a plurality of load supporting wire members or strands. Col. 3, lines 16-20. In various embodiments, the wire rope in its entirety (which includes the plurality of wires or strands) is encased in sheaths of materials having differing properties where the properties of the sheath material are used to detect an amount or wear on the suspension rope. Therefore, Lamb teaches a plurality of wire members or strands that are sheathed, whereas the instant invention teaches a core comprised of a single yarn that is surrounded by a plurality of respective layers.

In view of the foregoing, since the relied upon portions of the cited references do not disclose a "core comprised of a single yarn," Applicants respectfully request that the § 102 rejections be withdrawn.

In contrast to the instant invention, Dapsalmon is directed to a knitted piece of protective gear, such as a glove, to protect a person's limbs against injury. *See* col. 1, line 66 - col. 2, line 3. The piece of protective gear is knitted from yarns containing a core of a first color and an outer fiber covering of a second color. Damage to the knitted protective gear is detected by a change in color on the outer surface of the protective gear. Hence, Dapsalmon is not directed to detecting wear in an industrial fabric by detecting wear of the individual filaments that form the industrial fabric. The Office Action asserts that although Dapsalmon does not specifically disclose the use of a plurality of respective outer layers, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the filament of

Dapsalmon with a plurality of outer layers based on the combination of Dapsalmon with either Parsey or Lamb. Applicants respectfully disagree.

Regarding Moriarity, as depicted in Figure 3, Moriarity is directed to a sheath/core yarn 20 that includes a core yarn 22 and a single sheath 24. Col. 3, lines 6-33. The sheath/core yarn of Moriarity is for use in an industrial fabric. In contrast, the instant invention is directed to a filament having a core surrounded by a plurality of respective layers. The Office Action states that although Moriarity does not specifically mention the use of a plurality of respective outer layers, Parsey and Lamb each disclose that it is known in the wear detecting filament art that a core may be surrounded by a plurality of outer layers to indicate the degree of wear. Therefore, the Office Action asserts that it would have been obvious to a person skilled in the art to make the filament of Moriarity with a plurality of outer layers. Applicants again respectfully disagree.

In the instant case, the fields of invention between the instant invention and Moriarity and Parsey, Lamb and Dapsalmon, are dissimilar and unrelated. One of ordinary skill in the art of designing a multilayer filament for use in an industrial fabric to detect fabric wear would not have been motivated to combine Dapsalmon or Moriarity with either Lamb or Parsey to achieve the claimed invention.

In response to Applicants' arguments in the previous Amendment dated August 4, 2005 that Parsey, Lamb and Dapsalmon are nonanalogous art to both the instant invention and Moriarity, the Office Action maintains that the cited art is analogous to both the instant application and Moriarity. Applicants respectfully disagree

Applicants still maintain that Parsey, Lamb and Dapsalmon are nonanalogous art to both the instant invention and Moriarity, and therefore cannot be properly applied to reject Applicants' claims. As previously discussed, Applicants' invention is directed to a multilayer

filament having a core comprised of a single yarn surrounded by a plurality of respective layers that are used to indicate the level of wear of an industrial fabric constructed therefrom. Moriarity is directed to a sheath/core yarn that includes a core yarn and a single sheath where the sheath core yarn is used to construct an industrial fabric. Parsey, in contrast, is directed to a rope structure constructed from a core of at least one bundle of filaments, wherein the core may be bound by a steel tape or wire or sheathed with two organic coatings of different colors. Lamb, in contrast, is directed to suspension ropes having polyurethane sheaths as used, for example, in an elevator assembly. Lastly, Dapsalmon, in contrast, is directed to a knitted piece of protective gear, such as a glove, to protect a person's limbs against injury.

It is well established that nonanalogous art cannot be considered pertinent prior art under § 103 and therefore cannot be relied upon as a "basis for rejection of an applicant's invention." See M.P.E.P. § 2141.01(a) (quoting *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)). The determination as to whether a reference is analogous art is two fold. First, it must be decided if the reference is within the field of the inventor's endeavor. If it is not, it must then be determined whether the reference is "reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d at 1446. The Federal Circuit has held:

A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.

In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992).

In the present case, the Parsey, Lamb and Dapsalmon references do not satisfy the above well-established test of a reference falling into the category of analogous art. First, the references are not within the field of the instant inventors' endeavor. As previously discussed,

the instant invention and Moriarity relate to filaments for use in industrial fabrics. In contrast, Parsey relates to rope structures; Lamb relates to suspension ropes; and Dapsalmon relates to knitted protective gear such as a glove. Further evidencing the different fields of invention between the instant invention and Parsey, Lamb and Dapsalmon, are the USPTO classifications of the references. *See* M.P.E.P. § 2141.01(a). As detailed in the Application Data tab on the PAIR system for the instant application, the instant invention is classified in class 442. Similarly, Moriarity is classified in classes 442 and 139. In contrast, Parsey is classified in classes 264 and 156; Lamb is classified in classes 340, 73 and 324; and Dapsalmon is classified in class 2. The classes are defined as follows:

Class 442 (Applicant's invention and Moriarity): Fabric (Woven, Knitted or Nonwoven Textile or Cloth, etc.)

Class 139 (Moriarity): Textiles: Weaving

Class 264 (Parsey): Plastic and Nonmetallic Article Shaping or Treating: Processes

Class 156 (Parsey): Adhesive Bonding and Miscellaneous Chemical Manufacture

Class 340 (Lamb): Communications: Electrical

Class 73 (Lamb): Measuring and Testing

Class 324 (Lamb): Electricity: Measuring and Testing

Class 2 (Dapsalmon): Apparel

Accordingly, Parsey, Lamb and Dapsalmon are neither within the field of the instant inventors' endeavors, nor are they within the field of the Moriarity reference applied in combination.

Secondly, Parsey, Lamb and Dapsalmon are not reasonably pertinent to the particular problem with which the instant inventors were involved, thus failing the second prong of the test. As previously stated, Parsey relates to rope structures; Lamb relates suspension ropes; and

Dapsalmon relates to knitted protective gear such as a glove. In contrast, the instant invention is directed to problems associated with wear of an industrial fabric. It is clear that the matters with which Parsey, Lamb and Dapsalmon deal would not logically have commended themselves to the instant inventors' attention in considering the problem to be solved by the instant invention.

Therefore, as Parsey, Lamb and Dapsalmon fail both prongs of the analogous art test, they are nonanalogous art to the instant invention and cannot be properly applied in an obviousness analysis.

Moreover, while the USPTO classification is some evidence of analogy, similarities and differences in structure and function carry more weight. *In re Ellis*, 476 F.2d 1370, 1372 (C.C.P.A. 1973). As previously discussed, the Applicants' invention is directed to filaments that are used to detect wear in an industrial fabric. In contrast, neither Parsey, Lamb nor Dapsalmon perform a function similar to detecting wear of an industrial fabric. Instead Parsey relates to detecting wear of rope structures comprised of bundles of filaments; Lamb relates to detecting wear of suspension ropes for use in, for example, elevator assemblies, and Dapsalmon is directed to detecting wear in knitted protective gear, such as a glove. Hence, the differences in structure and function of the cited references are further evidence of nonanalogous between Applicants' invention and the cited references.

Since, as outlined above, Parsey, Lamb and Dapsalmon are nonanalogous to both the instant invention and Moriarity, it is requested that the claim rejections under § 103 be withdrawn. In addition, Applicants also respectfully request that the obviousness-type double patenting rejections be withdrawn as well. In the alternative, it is respectfully requested that the Examiner hold the Moriarity rejections in abeyance until one or more of claims 1-4, 6, 13-18, 20, 27 and 28 are found allowable.

For at least the foregoing reasons, Applicants respectfully submit that amended independent claims 1 and 15 patentably distinguish over Parsey, Lamb, Dapsalmon and Moriarity, either alone or in combination, and are therefore allowable. Further, claims 2-4, 6 and 14 that depend from claim 1 and claims 16-18, 20 and 28 that depend from claim 15, are allowable therewith.

Statements appearing above with respect to the disclosures in the cited references represent the present opinions of the Applicant's undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.


CONCLUSION

In view of the foregoing, Applicants submit that the instant claims should be allowed and that the instant application is now in condition for allowance. Applicants further submit that this After-Final Amendment does not require an additional search. Therefore, Applicants respectfully request entry of this After-Final Amendment and favorable reconsideration of the application, withdrawal of the rejections, and prompt issuance of the Notice of Allowance.

Please charge any fees incurred by reason of this response and not paid herewith to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By:


Ronald R. Santucci
Reg. No. 28,988
(212) 588-0800